

REMARKS/ARGUMENTS

Claims 1, 3, 7, 24 and 25 are pending in this application. Claims 2, 4-6, 8-23, 26 and 27 have been previously cancelled.

Interview Summary

The Applicant would like to express her gratitude for the time Supervisory Patent Examiner (SPE) Dr. Weber spent discussing the 35 U.S.C. §103 rejection with the Applicant's representative during a telephonic interview December 19, 2007. During the interview an agreement was reached that the aforementioned rejection is not sustainable. The Applicant and SPE Jon Weber agreed that the art cited refers to spongillidae and to *Spongilla fragilis*. There is no motivation or suggestion in either reference to make a pharmaceutical from *Spongilla lacustris*. This will be discussed more fully in the Applicant's response *infra*.

Clarification of Claim 27

Claim listing filed on July 19, 2006, and January 31, 2007, do not list claim 27. Clarification to the status of claim 27 is solicited. Claim 27 has been cancelled.

Objection to Specification

The specification is objected to because line one of page 1 of specification, in its present form does not properly cite the application priority data. Applicant has updated the status of Priority U.S. 10/186,996 to correct grammatically or idiomatically incorrect language. The status of Application 10/186,996 has also been updated to reflect that is now abandoned.

The specification is object to because at different places in the specification, grammatically or idiomatically incorrect language (e.g. missing comma between the words "invention" and "an" at Line 1 of Page 15, Paragraph [0060]; word "presently" at

Page 28, Line 18) has been presented. Paragraphs [0060] and [0098] of the published application have been carefully revised to comply with 35 U.S.C. § 112, first paragraph.

Applicant's cooperation was requested in correcting any errors of which applicant may have become aware in the specification. The Applicant did not become aware of any additional errors and as such, no further changes were made.

Objection to Claims

Claims 1, 3, 7, 24 and 25 are objected to because the word "species" in the phrase "fresh water sponge of the species *Spongilla lacustris*," as currently presented, is misleading and not according to the art-approved terminology. Applicant does not agree with this rejection, however, in order to expedite prosecution, Applicant has amended claim 1 to remove the word "species."

At line 1 of each of the claims 3, 7, 24 and 25, before the word, "wherein" a "comma" should be inserted. Applicant has amended claims 3, 7, 24 and 25 to add a "comma" before the word "wherein."

Objection to the Abstract

Legal language (e.g., "without limitation" or "embodiment") should not be used in an abstract. Applicant has amended the abstract to remove such legal language.

Rejection Under 35 U.S.C. § 112

Claim 25 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office argues "irrigation water" and "floral water" render claim 25 incomprehensible. The Applicant respectfully disagrees. "Irrigation water" and "floral water" are definite, well-known terms, commonly used by persons skilled in the art. (see, for examples of "floral water," U.S. Patent No.

7,115,255, column 7, line 55; U.S. Patent No. 7,083,800, claim 26; and, U.S. Patent No. 7,078,047, column 5, line 11; and for examples of "irrigation water," U.S. Patent No. 7,306,946, column 33, line 11; and, U.S. Patent No. 7,271,128, examples 1 through 4.) As such, the Applicant respectfully requests reconsideration and withdrawal of this rejection and submits this application is ready to publish.

Rejection Under 35 U.S.C. § 103

Claims 1, 3, 7 and 24 are rejected under 35 U.S.C. § 103(a) as obvious over combined teachings from RU 2 182 820 C1, issued May 27, 2002 (herein referenced as RUC1) in view of CN 1152455, published June 25, 1997 (herein after referred as CN455). The Applicant respectfully disagrees.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the Office is required to determine the scope and content of the prior art, ascertain the differences between the prior art and the claims in issue, and resolve the level of ordinary skill in the pertinent art. (*Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18; MPEP §§ 2141-2142.) Often times, this will require the Office to take a "step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made... [and] make a determination whether the claimed invention 'as a whole' would have been obvious at the time to that person." (MPEP § 2142) In the present case, the Applicant respectfully asserts that the hypothetical person of ordinary skill in the art at the time of the invention would not have been motivated to combine the cited references and to make the leap of knowledge necessary to conceive the presently claimed invention.

In the present case, the rejected claims are directed at *therapeutic compositions* useful for treating skin disorders such as, but not limited to, acne. The claimed therapeutic compositions were invented by a medical doctor specializing in dermatology, which represents the person having ordinary skill in the related art. Therefore, in order to establish a *prima facie* case of obviousness in the instant case, the Office must establish that a medical doctor specializing in dermatology would have

been motivated to combine the cited references and having done so, would arrive at the claimed therapeutic compositions.

It is axiomatic that there must be some identifiable reason that would have prompted a person of ordinary skill in the art to combine elements found in the prior art in the way the claimed invention does. "... [A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art... it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l v. Teleflex, Inc.*, 550 U.S. ___, 127 S. Ct. 1727 (2007) (emphasis added). That is, there must be some motivation for the skilled artisan to combine the cited references.

Motivation can be found *inter alia* only when the cited references are analogous. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP § 2141.01(a)(I), quoting *In re Oetiker*, 977 F.2d 1443,1446 (Fed. Cir. 1992). In the present case, the Applicant respectfully asserts that RUC1 and CN455 are *not* analogous and in fact, are from completely disparate fields of endeavor. A skilled dermatologist would not seek to combine such disparate references when attempting to solve the problem the presently claimed invention addresses, specifically, treating skin conditions such as acne.

The first reference cited, RUC1, teaches cosmetic skin creams that may include small amounts of organic materials derived from spongillidae, a broad family of fresh water marine life. Arguably, because the cosmetic compositions described in RUC1 are applied topically to the skin, there is at least a tangential relationship between the field of endeavor in the presently claimed invention and RUC1. However, CN455 is completely non-analogous to RUC1 and thoroughly unrelated to the field of endeavor of the presently claimed invention. CN455 teaches an herbal concoction comprising, among other ingredients, sieved *Spongilla fragilla* sealed in a plastic bag worn

externally mid-torso for treating male impotence. The concoction containing the *Spongilla fragilla* never contacts the skin and is not used for any known or accepted medical use. A skilled medical doctor, especially a dermatologist, would not seek the teachings of such a reference when conceiving a therapeutic composition for treating acne.

Therefore, the Applicant respectfully asserts that the Office has failed to establish a *prima facie* case of obviousness because the skilled artisan would not be motivated to combine the teaching of a reference directed at cosmetic skin creams with a non-analogous reference teaching an externally worn plastic bag for treating impotence to arrive at the presently claimed invention.

However, assuming *arguendo* that the non-analogous references RUC1 and CN455 were combined, a *prima facie* case of obviousness still has not been established. The combined references fail to teach all of the limitations of the claimed invention. Claim 1 of the present application specifically recites *Spongilla lacustris*. Neither of the cited references teaches this limitation. Only through the use of impermissible hindsight could an argument be made that the recitation of spongillidae in RUC1 or *Spongilla fragilla* in CN455 could render a claim specifically reciting the limitation *Spongilla lacustris* obvious. Such an argument is untenable and does not meet the legal requirements for establishing a *prima facie* case of obviousness.

In summary, the art cited refers to spongillidae and to *Spongilla fragilis*. There is no motivation or suggestion in either reference to make a pharmaceutical from *Spongilla lacustris*; therefore, for at least the reasons stated *supra*, the Applicant respectfully requests that the Office withdraw the 35 U.S.C. § 103 rejection of claims 1, 3, 7 and 24.

The Applicant believes that this response to the examiner's request is complete and that the present case is now ready to be passed to allowance. We appreciate the examiner's diligence in regards to this important application.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-3207.

Respectfully submitted,

Dated: January 2, 2008

/Louis C. Cullman/
Louis C. Cullman
Registration No. 39645
CUSTOMER NUMBER: 45,200

KIRKPATRICK & LOCKHART PRESTON GATES ELLIS LLP
1900 Main Street, Suite 600
Irvine, California 92614-7319
Telephone: (949) 253-0900
Facsimile: (949) 253-0902